

REMARKS

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This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejections under 35 USC § 112

In this response, claims 1, 5 -8, 11-12 have been amended in a manner which obviates the use of the term "adapted." The amendments proposed in this response replace this term with "configured." It is submitted that this overcomes any objection that may be based on the cited case *In re Hutchinson*, 69 USPQ 138.

It should be noted that this amendment does not acquiesce to the position taken. Below are listed two decisions by the Board of Appeals in the 2001 – 2003 time frame that make it clear that the term "adapted" does not render a claim indefinite.

These are:

- 1) Ex parte PETER J. BECKAGE  
Appeal No. 2003-0242  
Application No. 09/484,604  
Before COHEN, STAAB, and NASE,  
and
- 2) Ex parte RALPH B. BRICK  
Appeal No. 2000-1794  
Application 08/901,171  
Before ABRAMS, MCQUADE, and BAHR,

While these decisions are not published and do not establish binding precedents it makes it clear that the PTO no longer holds with the findings of an out of date case decided some 58 years ago back in 1946. Copies are provided in Appendix A.

Rejections under 35 USC § 103

- 1) The rejection of claims 1-3 and 5-12 under 35 USC (a) as being unpatentable over Arrieta (EP 1179811) is respectfully traversed.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

Arrieta (EP 1179811) teaches a form of banknote with a security feature in the form of a memory chip inductively powered by RF. The chip is concealed beneath a hologram which also provides the antenna for the memory chip. The document discloses the production of banknotes, but as noted in the rejection, does also contain a brief listing of alternative "security documents."

However, even if the teaching of this document were to be considered in conjunction with other disclosures (in particular, those of documents in which the content is specific to a bearer of a document) is not at all clear if the claimed subject matter would be arrived at in at least that the Arrieta (EP 1179811) document is generally unspecific as to the nature of any content held by the memory chip.

The rejection acknowledges that Arrieta (EP 1179811) does not disclose a memory circuit being protected from access by an unauthorized reader and that this reference is therefore silent on this point. Nevertheless, the rejection proceeds to allege that "mutual verification between a reader and a security document are well known in the art". While mutual verification may *arguendo* be known per se, it is strongly disagreed that it is well known in this specific context or that there is any motivation whatsoever in EP 1179811 to introduce and use the same.

US 6257486 is cited in support of this position, but this document relates to smart cards, not documents – a technical area in which it is known for mutual verification to occur as there is a clear danger to the user of a smart card if their smart card is subverted – the smart card plays a positive role in interaction with electronic systems (such as banking systems). There is, therefore, no showing in the rejection as to why the hypothetical person of ordinary skill working from EP 1179811 would be in any way motivated to consider the disclosure of the '486 reference.

The only suggestion in support of this position is taken from EP 1179810 teaches "protecting of the information from the public". However, this reference is mentioned in passing and is not cited per se against the claimed subject matter. Further, EP 1179811 does not suggest this and in fact is such as to disclose that "the general public should not notice the incorporation of a security device" consequently "it is necessary to hide it to prevent destructive manipulation and illegal modification".

As will be appreciated, preventing reading of the stored data by an unauthorised reader has nothing to do with physically hiding the storage device, but relates to data privacy in that it ensures that the data can only be seen by those demonstrably entitled to see it – an issue on which EP 1179811 is wholly silent.

The above comments are also applied to the remaining independent claims. In addition, in connection with claims 10 to 12, it should be noted that EP 1179811 is entirely silent as to the possibility of storing information relevant to the bearer of the document (indeed, it is difficult to see how this could make any sense in the context of a banknote which is the basic object of the EP 1179811 disclosure.

It is submitted that if the teachings of US 6257486 and EP 1179810 are being relied upon for the sake of rejection then it would seem appropriate to have this reflected in the written record.

- 2) The rejection of claim 4 under 35 USC § 103(a) as being unpatentable over Arrieta (EP 1179811) further in view of Minkus, is respectfully traversed.

In this rejection it is acknowledged that Arrieta (EP 1179811) is silent as to the use of tamper evident strips but asserts that tampering with the hologram would lead to destruction/modification of the hologram to the degree that the tampering would be evident. Applicants take the position that this is unsupported conjecture. A citation showing this to be fact is submitted to be necessary (MPEP 2144.03).

The position is then taken that the hologram is, given a broad interpretation, itself a tamper evident strip. However, irrespective of this, the rejection cites Minkus to teach tamper evident strips and asserts that it would be obvious to provide visual means of detecting tampering.

It is submitted that the above positions are mutually exclusive and thus such as to render the purportedly obvious combination untenable.

First, if the hologram would provide the tamper evident member as alleged then there would be no need at all to seek out redundant teachings pertaining to such arrangements

Second, the provision of strips such as the ultrasonic weldments, which are clearly visible (see Fig. 1 of Minkus), on a hologram would not be contemplated. Minkus discloses at column 2, line 59 – column 3, line 6 that:

In order to render the laminant shown in FIG. 2 tamper resistant, ultrasonic weldments 25 are applied to the laminated card 11. In this example, two weldments 25 are applied to extend across the width of the card in the area containing the photograph 19. The **weldments create surface distortion 27** which are visible to a viewer but do not distort the photograph to such an extent that it is not recognizable by a viewer. The weldment 25 bonds together both of the sheets 13 and 15 in such engagement that they cannot be separated without virtual destruction of the material of the sheets. Further, an attempt to break the weldments will change the surface distortion 27 in the area of the photograph 19, thereby clearly indicating to a viewer that at least the photographic area 19 of the identification data 17 has been changed or manipulated. (Emphasis added)

The provision of such strips such as suggested in Minkus would deface the hologram by producing distortions of the very images which are sought to be generated by the hologram to the point of at least partially defeating the purpose of the hologram. It is submitted that the hypothetical person of ordinary skill would not contemplate this kind of modification without very clear teachings to do so.

Conclusion

It is respectfully submitted that the claims pending in this application contain subject matter which is neither disclosed nor rendered obvious the by the art of record. Favorable reconsideration and allowance of this application is courteously solicited.

Date July 23, 2004

HEWLETT-PACKARD COMPANY  
Customer Number: 22879

Respectfully submitted,

By 

William T. Ellis  
Registration No. 26,874

Keith J. Townsend  
Registration No. 40,358



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte PETER J. BECKAGE

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Appeal No. 2003-0242  
Application No. 09/484,604

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ON BRIEF

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 32 and 43. Claims 33 to 42, the only other claims pending in this application, have been withdrawn from consideration.

We REVERSE.



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Application No. 09/484,604

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### BACKGROUND

The appellant's invention relates to a method and apparatus for determining chemical mechanical polishing pad conditioner effectiveness (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|                        |           |               |
|------------------------|-----------|---------------|
| Sandhu et al. (Sandhu) | 5,036,015 | July 30, 1991 |
| Birang et al. (Birang) | 5,743,784 | Apr. 28, 1998 |

Claims 21 to 32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 32 and 43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Birang in view of Sandhu.

Claims 1 to 32 and 43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sandhu in view of Birang.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 9, mailed May 21, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed March 26, 2002) and reply brief (Paper No. 10, filed July 29, 2002) for the appellant's arguments thereagainst.

#### OPINION

Initially we note that the restriction issue raised by the appellant on pages 3, 9 and 10 of the brief relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not further review this issue.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.



### **The indefiniteness rejection**

We will not sustain the rejection of claims 21 to 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See *In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's rational for this rejection is set forth in the answer (pp. 3-4) as follows:

the use of the terminology "adapted to" makes the claims vague and indefinite because the scope of the claims can not be ascertained, since it has been held the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The use of the terminology "adapted to" in claim 21 does not render claims 21 to 32 vague and indefinite since the scope of the claims can be ascertained. As set forth by the examiner, the recitation that an element is "adapted to" perform a function is a limitation which requires only that the structure be able to perform the function. As

such, the scope of the claims can be ascertained with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claims 21 to 32 under 35 U.S.C. § 112, second paragraph, is reversed.

#### **The obviousness rejections**

We will not sustain the rejection of claims 1 to 32 and 43 under 35 U.S.C. § 103 as being unpatentable over Birang in view of Sandhu or the rejection of claims 1 to 32 and 43 under 35 U.S.C. § 103 as being unpatentable over Sandhu in view of Birang.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The teachings of the applied prior art (i.e., Birang and Sandhu) have been adequately set forth in the brief and answer. In our opinion, the combined teachings of the applied prior art would not have suggested the claimed subject matter. In that

regard, absent the use of impermissible hindsight,<sup>1</sup> we fail to discern any suggestion, incentive or motivation in the applied prior art to combine the teachings thereof to arrive at the claimed invention. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The applied prior art must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In this case, the examiner's alleged motivations as set forth in the obviousness rejections under appeal (answer, pp. 4-6) are, in our belief, based on the appellant's disclosure and not from the teachings of the applied prior art. In our view the combined teachings of the applied prior art would have suggested a system in which semiconductor wafers are polished as taught by Sandhu and that the polishing pad of Sandhu be thereafter conditioned as taught by Birang, not the claimed invention.

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<sup>1</sup> The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

On page 9 of the answer, the examiner asserts that Sandhu teaches a means of measuring the surface friction "equivalent" to that of Birang, thus implying that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have substituted Sandhu's means of measuring the surface friction for Birang's means of measuring the surface friction. We do not agree that Sandhu teaches a means of measuring the surface friction "equivalent" to that of Birang. In that regard, Sandhu teaches a means of measuring the surface friction which relies on a change in the coefficient of friction between the wafer 10, polishing slurry 18, and polishing platen 16 to change the load or amperage draw of the drive motors 26, 28. Specifically, as the oxide coating of a wafer 10, as shown in Figure 1 of Sandhu, is removed to the plane of the tops of the IC devices the coefficient of friction will change and that change is detected by a different amperage draw of the current meters 22, 24. Since no such "equivalent" change occurs in the conditioning process of Birang (i.e., neither the conditioning head 12 nor the polishing pad 14 undergoes an abrupt change in the coefficient of friction as when the oxide coating of a wafer 10 is removed to the plane of the tops of IC devices as in Sandhu), there is no suggestion, incentive or motivation in the applied prior art to combine the teachings thereof to arrive at the claimed invention. The mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior

art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 32 and 43 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 to 32 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 to 32 and 43 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

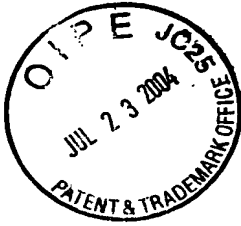
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JVN/jg



The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RALPH B. BRICK

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Appeal No. 2000-1794  
Application 08/901,171

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HEARD: May 15, 2001

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Before ABRAMS, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ralph B. Brick appeals from the final rejection of claims 1 through 13, all of the claims pending in the application.

THE INVENTION

In general, the invention relates to a well known type of packaging assembly comprising a wrapping material for covering an article and an elongated tape having a hidden portion disposed internally between the article and the wrapping material and a visible gripping portion disposed externally of

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the wrapped article to facilitate removal of the wrapping material from the article. In the appellant's package assembly, "the visible gripping portion of the elongated tape [has] a first message associated therewith and the hidden portion of the elongated tape [has] a second message associated therewith intellectually compatible with the first message which becomes available for viewing upon unwrapping the wrapping material from the article" (specification, page 3). A copy of claims 1 through 13 appears in the appendix to the appellant's main brief (Paper No. 18).

#### THE REFERENCES

The references relied on by the examiner to support the final rejection are:

|         |           |               |
|---------|-----------|---------------|
| Lenkoff | 3,826,499 | Jul. 30, 1974 |
| Hill    | 5,645,300 | Jul. 8, 1997  |

"Hershey's Kisses chocolates,"  
<http://www.hersheys.com/totally/product/kisses> (downloaded January 12, 1999, 12:46PM) (Hersheys.com)<sup>1</sup>

#### THE REJECTIONS

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<sup>1</sup> Although the download date of this reference is subsequent to the July 28, 1997 filing date of the instant application, it is not disputed that the subject matter discussed in the reference, particularly the Hershey's Kisses packaging arrangement, is prior art with respect to the appellant's invention.



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Claims 1 through 11 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hersheys.com.

Claims 10 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hersheys.com in view of Lenkoff.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hill.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 18 and 20) and to the examiner's final rejection and answer (Paper Nos. 14 and 19) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### DISCUSSION

##### I. The examiner's refusal to enter the amendment filed subsequent to final rejection

On March 28, 2000, the appellant filed an amendment (Paper No. 15) subsequent to final rejection which has been refused entry by the examiner (see the advisory action dated April 5,

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2000, Paper No. 16). The appellant (see pages 2 and 3 in the reply brief) suggests that this Board has the authority to remand the application to the examiner with instructions to enter the amendment, and seemingly urges us to do so. It is well settled, however, that the refusal of an examiner to enter an amendment after final rejection is a matter of discretion reviewable by petition to the Commissioner rather than by appeal to this Board. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we shall not review or further discuss this matter.

II. The 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 11 and 13

The examiner considers claims 1 through 11 and 13 to be indefinite because

[i]n claims 1-11 and 13 the use of the recitation "adapted to be" renders the claim indefinite. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re [Hutchison], 69 USPQ 138. In claim 1, lines 6 and 7, the recitation "a wrapper hidden portion . . . within the inner surface of said wrapping material . . ." is not clear [final rejection, page 2].

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In further explanation of this position, the examiner states that

the use of the language "adapted to be" renders the claim indefinite because, for example, Appellant is not positively claiming the visible gripping portion being positioned externally of the wrapping material. The recitation "a wrapper hidden . . . within the inner surface of the wrapping material . . ." is not clear to the Examiner. The Examiner does not understand how the wrapper hidden portion is nested within the inner surface of said wrapping material. Is the Appellant referring to the elongated single, unitary tape as

being the "wrapper hidden portion"? How can the wrapper which is used to completely wrap the outer surface of the article, as claimed, hide within itself? [answer, page 4].

The examiner's determination that claims 1 through 11 and 13 are indefinite for these reasons is not well taken. The "adapted to be" terminology in the claims constitutes functional language which merely defines the claimed packaging assembly elements in terms of what they are intended to do. Contrary to the position taken by the examiner, there is nothing intrinsically wrong with the use of this technique in drafting a patent claim. See In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). The examiner's additional concern with the recitation in claim 1 of the "wrapper hidden

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portion" is also unfounded. When claim 1 is read, as it is required to be, in light of the underlying specification, it is reasonably clear that the "wrapper hidden portion" refers to a part of the elongated tape which is adapted to be nested within the inner surface of the wrapping material.

Thus, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 11 and 13.

III. The 35 U.S.C. § 103(a) rejection of claims 1 through 9 and 11 as being unpatentable over Hersheys.com

Hersheys.com discusses the familiar package for a Hershey's Kisses chocolate. It is not disputed that this package comprises a foil wrapper completely enclosing the chocolate and an elongated tape having a hidden portion lying between the wrapper and the chocolate and a visible gripping portion extending out of the wrapper and bearing the word "KISSES."

As conceded by the examiner (see page 3 in the final rejection), Hersheys.com does not respond to the limitations in independent claim 1, or the corresponding limitations in independent claim 11, requiring the visible gripping portion of the tape to have printed thereon a first response solicitive message and the spaced wrapper hidden portion of the tape to

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have printed thereon a second differing and responsive  
completing portion of the message intellectually compatible  
with and  
functionally pertaining to and completing the message. The  
examiner nonetheless concludes that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the necessary printed matter on the elongated tape for advertisement purposes as necessitated by the end user since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of packaging assembly

does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the elongated tape which is required for patentability [final rejection, pages 3 and 4].

Differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Where the printed

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matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id.

In the present case, claims 1 and 11 do indeed recite a specific functional relationship between the response solictive and responsive "printed matter" and the tape "substrate," i.e.

that the response solictive matter be printed on the visible gripping portion of the tape and that the responsive matter be printed on the spaced hidden portion of the tape. The examiner's conclusion that it would have been obvious to

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provide the Hersheys.com tape with these features is completely devoid of factual support. Hence, the examiner's ultimate conclusion that the differences between the subject matter recited in claims 1 and 11 and the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art must fall.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 and 11, or of claims 2 through 9 which depend from claim 1, as being unpatentable over Hersheys.com.

IV. The 35 U.S.C. § 103(a) rejection of claims 10 and 13 as being unpatentable over Hersheys.com in view of Lenkoff

Claims 10 and 13 depend, either directly or indirectly, from independent claims 1 and 11, respectively. Suffice to say that Lenkoff's disclosure of games having marking sheets printed with invisible ink and marking pens designed to make such printing visible does not cure the above noted deficiencies of Hersheys.com with respect to the subject matter recited in parent claims 1 and 11.

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Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 10 and 13 as being unpatentable over Hersheys.com in view of Lenkoff.

V. The 35 U.S.C. § 103(a) rejection of claim 12 as being unpatentable over Hill

Independent claim 12 recites an elongated tape and is similar to independent claims 1 and 11 in that it requires the tape to include opposed, i.e., opposite, extremities having printed thereon functionally compatible message portions which are response solicitive and responsive, respectively.

Hill discloses a label/wrapper composed of a flexible elongated strip of paper or plastic adapted to be wrapped around packages for food or other products. The label/wrapper may carry printed indicia relating to trademarks, logos, product names, cooking information, product coupons, recipes and the like.

In essence, the examiner (see page 5 in the final rejection) concedes Hill to be unresponsive to the printed matter limitations in claim 12 in the same sense that Hersheys.com is



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unresponsive to the printed matter limitations in claims 1 and 11. The examiner's position that these differences do not constitute patentable distinctions is substantively identical to that advanced with respect to claims 1 and 11 and the Hersheys.com reference and is unpersuasive for the same reasons.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 12 as being unpatentable over Hill.

#### VI. New rejection

The following new rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 1, 11 and 13, and claims 2 through 10 which depend from claim 1, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Independent claim 1 is unclear as to the relationship between the "single message" and the subsequently recited "first response solicitive message." Amending the recitation of the "first response solicitive message" to read as --a first

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response solicitive portion of said message-- would overcome this problem.

Independent claim 11 is similarly unclear as to the relationship between the "single message" and the subsequently recited message/message portion limitations. Moreover, these subsequently recited message/message portion limitations are inconsistent in and of themselves. For example, the terms "said first portion" and "said written intellectually response solicitive message" lack a proper antecedent basis.

Finally, claim 13 is unclear in that the preambular recitation of "The elongated tape of Claim 11" and the recitation of "said messages" lack a proper antecedent basis.

#### SUMMARY

The decision of the examiner to reject claims 1 through 13 is reversed; and a new rejection of claims 1 through 11 and 13 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37

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CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b).

NEAL E. ABRAMS )

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| JENNIFER D. BAHR            | ) |                 |
| Administrative Patent Judge | ) |                 |

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